

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Shintaro KOBAYASHI et al.

Confirmation No. 1087

Appln. No. : 10/560,077
(U.S. National Stage of PCT/JP2004/008364)

Group Art Unit: 4181

I.A. Filed : June 9, 2004

Examiner: Syed IQBAL

For : ADSORBENT, ADSORPTION APPARATUS, AND METHOD FOR
MANUFACTURING THE ADSORPTION APPARATUS

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. §§ 121 and 372 mailed from the U.S. Patent and Trademark Office on November 25, 2008. Inasmuch as the one-month shortened statutory period for reply is set in the Office Action to expire on December 29, 2008 (December 25, being a holiday, December 26, the USPTO being closed, December 27, 28 being a Saturday and Sunday), this response is timely filed and a Request for Extension of Time is not necessary. However, if any additional fees are necessary to maintain the pendency of this application, the Office is authorized to charge such fee to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction under 35 U.S.C. § 121 and § 372 to one of the following inventions:

- I. Group I, claims 1-7, drawn to an adsorbent with an apatite represented by a formula $\text{Ca}_{10}(\text{PO}_4)_6((\text{OH})_{1-x}\text{A}_x)_2$ where A is a halogen and $0 \leq x \leq 1$ and a trivalent metal ion is bonded to a phosphate group.
- II. Group II, claims 8-12, drawn to an apparatus comprising a column filled with an adsorbent of claim 1.
- III. Group III, claims 13-16, drawn to a process of making an adsorption apparatus wherein a trivalent metal is passed through a column with the apatite represented by $\text{Ca}_{10}(\text{PO}_4)_6((\text{OH})_{1-x}\text{A}_x)_2$ where A is a halogen and $0 \leq x \leq 1$.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse, the invention set forth in **Group I, claims 1-7**, drawn to an adsorbent with an apatite represented by a formula $\text{Ca}_{10}(\text{PO}_4)_6((\text{OH})_{1-x}\text{A}_x)_2$ where A is a halogen and $0 \leq x \leq 1$ and a trivalent metal ion is bonded to a phosphate group.

TRAVERSE

Notwithstanding the election of the claims of Group I in order to be responsive to the requirement for restriction, Applicants respectfully traverse the requirement.

Applicants note that this application is a national stage application, and thus under unity of invention practice, the Examiner must establish that the claims lack unity of invention under PCT Rule 13.1 and 37 C.F.R. § 1.475. Applicants note that the restriction Requirement indicates that the technical feature linking Groups I, II and III “is the apatite of the composition defined by formula $\text{Ca}_{10}(\text{PO}_4)_6((\text{OH})_{1-x}\text{A}_x)_2$.” The Office asserts that in view of the teaching of JP10118167, the special technical feature linking Groups I-III does not define a contribution over the art.

Initially, Applicants note that the Office has not made any art-based rejections over the claims of record, and specifically reserve the right to rebut any rejections if and when such rejections are made.

Applicants respectfully traverse the finding of lack of unity of invention because Applicants respectfully submit that the subject matter that the Office has identified as being shared between the respective Groups, is neither anticipated by nor obvious in view of the prior art. Thus, contrary to the Office's position, the three Groups share subject matter that distinguishes over the prior art. Thus, Applicants respectfully request withdrawal of the requirement for restriction.

Still further, Applicants respectfully note that because the Office has found that the respective Groups share common subject matter, and concluded that because such subject matter is disclosed in the art, the Office will be required to withdraw the Restriction Requirement upon finding that the recited common subject matter is not disclosed in the art.

Still further, in particular, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under 1.475. In the instant situation, the requirement does not refer to 1.475, and does not indicate that the requirement is proper in view of this rule.

The requirement does point to PCT Rule 13.1 and PCT Rule 13.2. However, the requirement does not discuss 1.475(b)(1) which permits an international or a national stage application containing claims to different categories of invention to have unity of invention if the claims are drawn only to one of the following combinations of categories including a product and a process specially adapted for the manufacture of said product.

Therefore, the requirement for restriction is not proper, and should be withdrawn.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

If there are any comments or questions, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,
Shintaro KOBAYASHI et al.



Bruce H. Bernstein
Reg. No. 29,027

Stephen M. Roylance
Reg. No. 31,296

December 23, 2008
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191